

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Knight, *et al.*

Serial No.: 10/064,292

Filed: June 28, 2002

Title: Tooltip Hyperlinks

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APPEAL BRIEF

Honorable Commissioner:

This is an Appeal Brief filed pursuant to 37 CFR § 41.37 in response to the Final Office Action of July 6, 2006, and pursuant to the Notice of Appeal filed October 5, 2006.

REAL PARTY IN INTEREST

The real party in interest in accordance with 37 CFR § 41.37(c)(1)(i) is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences within the meaning of 37 CFR § 41.37(c)(1)(ii).

STATUS OF CLAIMS

Status of claims in accordance with 37 CFR § 41.37(c)(1)(iii): Sixteen claims are filed in the original application in this case. Claims 1-16 are rejected in the Final Office Action. Claims 1-16 are on appeal.

STATUS OF AMENDMENTS

Status of amendments in accordance with 37 CFR § 41.37(c)(1)(iv): No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Appellants provide the following concise summary of the claimed subject matter according to 37 CFR § 41.37(c)(1)(v), including references to the specification by page and line number and to the drawings by reference characters where applicable. Claims 1 and 9 are independent claims on appeal that claim computer program product aspects and data processing system aspects, respectively, of the present invention.

Independent claim 1 recites a computer program product embodied in a machine readable media and executable by a processor (described for example at page 3, lines

7-9, page 6, lines 4-24, and Figure 2 at reference numerals 201 and 207). The computer program product is for use with a computer system having a display screen, a switch, and a pointing device for moving a cursor image on the display screen (described for example at page 4, line 27, through page 5, line 7, page 6, lines 4-24, and Figure 2 at reference numerals 101, 210, 211, and 212). The computer program product includes program instructions for performing the steps of: displaying an object on the display screen (described for example at page 4, line 27, through page 5, line 7, and Figure 1(a) at reference numerals 101 and 102); displaying a tooltip on the display screen in response to the positioning of the cursor image over the object (described for example at page 5, lines 9-13, and Figure 1(b) at reference numerals 101, 102, and 105); and continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip (described for example at page 5, lines 15-19, and Figure 1(c) at reference numerals 101, 102, and 105).

Independent claim 9 recites a data processing system for use with a display screen, a switch, and a pointing device for moving a cursor image on the display screen (described for example at page 4, line 27, through page 5, line 7, page 6, lines 4-24, and Figure 2 at reference numerals 101, 210, 211, and 212). The data processing system includes: means for displaying an object on the display screen (described for example at page 4, line 27, through page 5, line 7, and Figure 1(a) at reference numerals 101 and 102); means for displaying a tooltip on the display screen in response to the positioning of the cursor image over the object (described for example at page 5, lines 9-13, and Figure 1(b) at reference numerals 101, 102, and 105); and means for continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip (described for example at page 5, lines 15-19, and Figure 1(c) at reference numerals 101, 102, and 105). The means for carrying out the acts described in claim 9 include a computer system described at page 6, lines 4-24, and Figure 2 in the original specification.

All such references to the specification identify descriptions and discussions that are part of the detailed descriptions of exemplary embodiments of the present invention in the present application. Such descriptions and discussions are not limitations of the claims in the present application. The only limitations of the claims are set forth in the claims themselves.

GROUND OF REJECTION

In accordance with 37 CFR § 41.37(c)(1)(vi), Appellants provide the following concise statement for each ground of rejection:

1. Claims 1, 3, 5-8, 9 and 14-16 stand rejected under 35 U.S.C. 102(e) as being anticipated by Lapidous (U.S. Patent No. 6,874,126).
2. Claims 2, 4 and 10-13 are rejected under U.S.C. 103(a) as being unpatentable over Lapidous (U.S. Patent No. 6,874,126).

ARGUMENT

Appellants present the following arguments pursuant to 37 CFR § 41.37(c)(1)(vii) regarding the four grounds of rejection in the present case:

**ARGUMENT REGARDING THE FIRST GROUND OF REJECTION:
CLAIMS 1, 3, 5-8, 9 AND 14-16 STAND REJECTED UNDER
35 U.S.C. 102(E) AS BEING ANTICIPATED BY LAPIDOUS**

Claims 1, 3, 5-8, 9, and 14-16 stand rejected under 35 U.S.C § 102(e) as being anticipated by Lapidous (U.S. Patent No. 6,874,126). To anticipate claims 1, 3, 5-8, 9, and 14-16 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Lapidous must disclose each and every element as set forth in Appellants' claims. The second requirement of anticipation is that Lapidous must enable Appellants' claims. Lapidous does not meet either requirement and therefore does not anticipate Appellants' claims.

Lapidous Does Not Disclose Each and Every Element
Of The Claims Of The Present Application

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Lapidous does not disclose each and every element of claim 1, and Lapidous therefore cannot be said to anticipate the claims of the present application within the meaning of 35 U.S.C. § 102.

Independent claim 1 of the present application claims:

1. A computer program product embodied in a machine readable media and executable by a processor, said computer program

product for use with a computer system having a display screen, a switch, and a pointing device for moving a cursor image on the display screen, said computer program product comprising program instructions for performing the steps of:

displaying an object on the display screen;

displaying a tooltip on the display screen in response to the positioning of the cursor image over the object,

continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip.

Lapidous Does Not Disclose Continuing To Display
The Tooltip In Response To The Movement Of The
Cursor From The Object To The Tooltip

The third element of claim 1 claims “continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip.” Regarding the third element of claim 1, the Final Office Action asserts that Figures 3A and 3B of Lapidous discloses the third element of claim 1. Specifically, the Final Office Action equates the “More Information” (325) inside the predefine control region (320) in Figures 3A and 3B of Lapidous with the object as claimed in the present invention. The Final Office Action further equates the tooltip (315) in Figures 3A and 3B of Lapidous with the tooltip as claimed in the present invention. The Final Office Action argues at pages 3 and 5 that Figures 3A and 3B disclose the third element of claim 1 because in Lapidous “the tooltip (315) must be continuously displayed while the cursor (330) is moving forward to the tooltip.” Appellants respectfully point out, however, that Lapidous discloses the exact opposite of what the Final Office Action asserts. Lapidous at column 7, line 60, through column 8, line 7, states:

Referring again to FIG. 3A, interface region 335 covers interface element 345 and cursor position 330 detected at the time interface element 345 became visible. When the cursor moves outside of both regions 335 and 320, tool tip 315 with its content is removed from the screen, as well as interface region 335 and interface element 345. However, if the user chooses to interact with the supplemental content of tool tip 315, the user can select interface element 345, causing a change in the display of the supplemental content. For example, the user can select interface element 345 to expand the display area of the supplemental content. The user can then perform various actions

pertaining to the supplemental content, as will be described in greater detail below. The display of the extended area can be cancelled by moving the cursor outside of the expanded area.

That is, Lapidous at column 7, line 60, through column 8, line 7, discloses that the tooltip (315) in Figure 3A of Lapidous is removed when the cursor of Lapidous moves from the “More Information” (325) inside the predefine control region (320) of Lapidous to the tooltip (315) of Lapidous because the cursor of Lapidous would have to move outside of both regions 335 and 320 in Figure 3A of Lapidous. Lapidous at Figures 3A and 3B, therefore, does not disclose continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip as asserted in the Final Office Action. Because Lapidous does not disclose each and every element and limitation of the Appellants’ claims, Lapidous does not anticipate Appellants’ claims, and the rejections should be withdrawn.

In arguing that Figures 3A and 3B disclose the third element of claim 1, the Examiner relies on the assertion above that “the tooltip (315) must be continuously displayed while the cursor (330) is moving forward to the tooltip” because, as the Examiner questions, “How can the user select the supplemental content (310) if the tooltip is not displayed continuously?” The cited portion of Lapidous above answers the Examiner’s question and explains how a user accesses the supplement content (310) of Lapidous when the tooltip is not continuously displayed in response to the movement of the cursor from the “More Information” (325) object of Lapidous to the tooltip (315) of Lapidous. Lapidous at column 7, line 60, through column 8, line 7, discloses that the user of Lapidous interacts with the supplemental content of tool tip (315) of Lapidous using the interface element (345) of Lapidous. When the user selects the interface element (345) of Lapidous, the window for the tooltip (315) of Lapidous may be expanded or the content in the main browser window may be

replaced with the supplement content in the tooltip (345) of Lapidous. *See* Lapidous at column 9, lines 25-32. Neither of these scenarios in Lapidous discloses continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip as asserted in the Final Office Action. Because Lapidous does not disclose each and every element and limitation of the Appellants' claims, Lapidous does not anticipate Appellants' claims, and the rejections should be withdrawn.

Lapidous Does Not Enable Each and Every Element
Of The Claims Of The Present Application

Not only must Lapidous disclose each and every element of the claims of the present application within the meaning of *Verdegaal* in order to anticipate Appellants' claims, but also Lapidous must be an enabling disclosure of each and every element of the claims of the present application within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the appellant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Lapidous places Appellants' claims in the possession of a person of ordinary skill in the art, Lapidous is legally insufficient to anticipate Appellants' claims under 35 USC 102(e). As explained above, Lapidous does not disclose each and every element and limitation of claim 1 of the present application. Because Lapidous does not disclose each and every element and limitation of claim 1, Lapidous cannot possibly place the elements and limitations of

claim 1 in the possession of a person of ordinary skill in the art. Lapidous cannot, therefore, anticipate claim 1 of the present application.

Relations Among Claims

Claims 1, 3, 5-8, 9 and 14-16 stand rejected under 35 U.S.C. 102(e) as being anticipated by Lapidous. For the reason discussed above, Lapidous does not anticipate independent claim 1 in the present application. Independent claim 1, therefore, is allowable. Independent claim 9 claims a data processing system of the computer program product claimed in independent claim 1. Independent claim 9 is allowable because independent claim 1 is allowable. The rejections of independent claims 1 and 9, therefore, should be withdrawn, and claims 1 and 9 should be allowed.

Claims 3, 5-8 depend from independent claim 1. Claims 14-16 depend from independent claim 9. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because Lapidous does not disclose each and every element of the independent claims, so also Lapidous cannot possibly disclose each and every element of any dependent claim. The rejections of claims 1, 3, 5-8, 9 and 14-16, therefore, should be withdrawn, and these claims also should be allowed.

ARGUMENT REGARDING THE SECOND GROUND OF REJECTION:

CLAIMS 2, 4 AND 10-13 ARE REJECTED UNDER U.S.C. 103(A)

AS BEING UNPATENTABLE OVER LAPIDOUS

Claims 2, 4, and 10-13 stand rejected under 35 U.S.C § 103(a) as unpatentable over Lapidous (U.S. Patent No. 6,874,126). To establish a prima facie case of

obviousness, the proposed modification of Lapidous must teach or suggest all of the claim limitations of claims 2, 4, and 10-13. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). For the reason discussed below, the Final Office Action does not teach or suggest all of the claim limitations of claims 2, 4, and 10-13. The Final Office Action, therefore, does not establish a prima facie case for obviousness, and the rejections should be withdrawn.

The Rejections Of Claims 2, 4, And 10-13 Rely On
The Previous 35 U.S.C. § 102 Rejections

The Final Office Action does not teach or suggest all of the claim limitations of claims 2, 4, and 10-13 because the rejections of claims 2, 4, and 10-13 rely on the previous 35 U.S.C. § 102 rejections. The previous 35 U.S.C. § 102 rejections argue that Lapidous discloses each and every element and limitation of independent claims 1 and 9. As Appellants have demonstrated above, however, Lapidous does not disclose each and every element of independent claims 1 and 9. Claims 2 and 4 depend from independent claim 1. Claims 10-13 depend from independent claim 9. Each dependent claim includes all of the limitations of the claims from which they depend. Because the proposed modification of Lapidous relies on the argument that Lapidous discloses each and every element of claims 1 and 9 and because Lapidous in fact does not disclose each and every element of claims 1 and 9, the proposed modification of Lapidous cannot teach or suggest all the claim limitations of claims 2, 4, and 10-13. The proposed modification of Lapidous, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

The Final Office Action Relies On Official
Notice Not Available To The Examiner

The Final Office Action does not teach or suggest all of the claim limitations of claims 2, 4, and 10-13 because the Final Office Action relies on Official Notice not available to the Examiner. Regarding the rejection of claims 2 and 10, the Final Office Action at page 4 states:

It would have been well known in the computer art that the Lapidous's system suggests the tooltip having an overlapping portion that does not overlap the object on the display screen and further the step of continuing to display the tooltip being in response to the movement of the cursor from the object to the overlapping portion of the tooltip, followed by the movement of the cursor from the overlapping portion to the non-overlapping portion of the tooltip.

That is, the Final Office Action makes a mere naked assertion that a fact is well known in the prior art with absolutely no objective evidence of record. According to MPEP § 2144.03, the Examiner may make use of Official Notice of facts outside the record only if such facts are capable of instant and unquestionable demonstration as being well-known in the art. Official Notice, however, may not be substituted for facts which cannot be instantly and unquestionably demonstrated. Applicants respectfully point out that Lapidous itself at column 2, lines 19-34, is evidence that the Office Notice taken in the Final Office Action cannot be instantly and unquestionably demonstrated stating:

It is known in the prior art to trigger automatic removal of the supplemental content by the cursor motion during the regular

navigation process. For instance, supplemental content known as a tool tip appears when cursor stops over the link or an interface element. Internet browsers, such as the Internet Explorer.TM. (RTM), developed by the Microsoft Corporation, remove each displayed tool tip from the screen when the cursor moves into the area of the tool tip or exits a screen region associated with a related link or an interface element. Due in large part to this easy removal method, tool tips are widely used both for the links inside the hypertext documents and for the elements of the application user interfaces. However, usefulness of tool tips is limited by the difficulty of interaction with their content since the cursor motion to the tool tip automatically removes the tool tip from the screen.

That is, Lapidous at column 2, lines 19-34, states that prior art teaches the removal a displayed tool tip from the screen when the cursor moves into the area of the tool tip or exits a screen region associated with a related link or an interface element. Lapidous, therefore, contradicts the statement in the Final Office Action that it is well known in the art to continue to display the tool tip is in response to the movement of the cursor from the object to the overlapping portion of the tool tip, followed by the movement of the cursor from the overlapping portion to the non-overlapping portion of the tool tip. Because the Final Office Action contradicts Lapidous itself, the Official Notice taken in the Final Office Action cannot be capable of instant and unquestionable demonstration as well-known in the art, and the Final Office Action may not make use of Official Notice of facts outside the record. The Final Office Action, therefore, does not demonstrate that the modification of Lapidous teaches or suggests all of the elements and limitations of claims 2 and 10. Because claims 4 and 11-13 depend from claims 2 and 10 respectively, the Final Office Action does not provide a combination of references that teaches or suggests all of the elements and

limitations of claims 4 and 11-13. The Final Office Action, therefore, cannot establish a prima facie case of obviousness, the rejections of claims 2, 4, and 10-13 should be withdrawn, and the claims should be allowed.

CONCLUSION OF APPELLANTS' ARGUMENTS

Claims 1, 3, 5-8, 9, and 14-16 stand rejected under 35 U.S.C § 102(e) as being anticipated by Lapidous (U.S. Patent No. 6,874,126). For the reasons discussed above, Lapidous does not disclose each and every element of claims 1, 3, 5-8, 9, and 14-16 and Lapidous does not place one of skill in the art in possession of claim 1, 3, 5-8, 9, and 14-16. Lapidous therefore does not anticipate claims 1, 3, 5-8, 9, and 14-16 and the rejections should be withdrawn. Appellants respectfully traverse each rejection individually and request reconsideration of claims 1, 3, 5-8, 9, and 14-16.

Claims 2, 4, and 10-13 stand rejected under 35 U.S.C § 103(a) as unpatentable over Lapidous (U.S. Patent No. 6,874,126) in view of Official Notice of well known prior art ("Official Notice"). Because the proposed combinations rely on the argument that Lapidous teaches each and every element of claims 1 and 9 and because Lapidous in fact does not teach or suggest each and every element of claims 1 and 9, the proposed combination cannot teach or suggest all the claim limitations of claims 2, 4, and 10-13. The proposed combination, therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn. Appellants respectfully traverse each rejection individually and request reconsideration of claims 2, 4, and 10-13.

In view of the forgoing arguments, Appellants submit that the rejections of claims 1-16 are improper, and Appellants respectfully request the Board to reverse the rejection of these claims and remand the case to the Examiner with an order to allow

the claims or issue a properly founded rejection.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date: November 1, 2006

Respectfully submitted,

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APPENDIX OF CLAIMS ON APPEAL

Claims 1-16 of the present application:

1. A computer program product embodied in a machine readable media and executable by a processor, said computer program product for use with a computer system having a display screen, a switch, and a pointing device for moving a cursor image on the display screen, said computer program product comprising program instructions for performing the steps of:

displaying an object on the display screen;

displaying a tooltip on the display screen in response to the positioning of the cursor image over the object,

continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip.

2. The computer program product of claim 1, wherein the tooltip has an overlapping portion that overlaps the object on the display screen, and a non-overlapping portion that does not overlap the object on the display screen, and the step of continuing to display the tooltip is in response to the movement of the cursor from the object to the overlapping portion of the tooltip, followed by the movement of the cursor from the overlapping portion to the non-overlapping portion of the tooltip.
3. The computer program product of claim 1, further comprising program instructions for performing the step of removing the tooltip from the display screen in response to the movement of the cursor both off the object and off the tooltip.

4. The computer program product of claim 2, wherein the tooltip includes a hyperlink displayed within the tooltip, further comprising program instructions for performing the step of displaying on the display screen linked data in response to the cursor being positioned over the hyperlink within the tooltip and the activation of the switch.
5. The computer program product of claim 3, wherein the tooltip includes a hyperlink displayed within the tooltip, further comprising program instructions for performing the step of displaying on the display screen linked data in response to the cursor being positioned over the hyperlink within the tooltip and the activation of the switch.
6. The computer program product of claim 1, further comprising program instructions for performing the step of removing the tooltip from the display screen in response to the movement of the cursor both off the object and off the tooltip.
7. The computer program product of claim 6, wherein the tooltip includes a hyperlink displayed within the tooltip, further comprising program instructions for performing the step of displaying on the display screen linked data in response to the cursor being positioned over the hyperlink within the tooltip and the activation of the switch.
8. The computer program product of claim 1, wherein the tooltip includes a hyperlink displayed within the tooltip, further comprising program instructions for performing the step of displaying on the display screen linked data in response to the cursor being positioned over the hyperlink within the tooltip and the activation of the switch.

9. A data processing system for use with a display screen, a switch, and a pointing device for moving a cursor image on the display screen, said data processing system comprising:
- means for displaying an object on the display screen;
- means for displaying a tooltip on the display screen in response to the positioning of the cursor image over the object; and
- means for continuing to display the tooltip in response to the movement of the cursor from the object to the tooltip.
10. The data processing system of claim 9, wherein the tooltip has an overlapping portion that overlaps the object on the display screen, and a non-overlapping portion that does not overlap the object on the display screen, and the means for continuing to display the tooltip is in response to the movement of the cursor from the object to the overlapping portion of the tooltip, followed by the movement of the cursor from the overlapping portion to the non-overlapping portion of the tooltip.
11. The data processing system of claim 10, further comprising means for removing the tooltip from the display screen in response to the movement of the cursor both off the object and off the tooltip.
12. The data processing system of claim 11, wherein the tooltip includes a hyperlink displayed within the tooltip, further comprising means for displaying on the display screen linked data in response to the cursor being positioned over the hyperlink within the tooltip and the activation of the switch.
13. The data processing system of claim 10, wherein the tooltip includes a hyperlink displayed within the tooltip, further comprising means for displaying on the

display screen linked data in response to the cursor being positioned over the hyperlink within the tooltip and the activation of the switch.

14. The data processing system of claim 9, further comprising means for removing the tooltip from the display screen in response to the movement of the cursor both off the object and off the tooltip.
15. The data processing system of claim 14, wherein the tooltip includes a hyperlink displayed within the tooltip, further comprising means for displaying on the display screen linked data in response to the cursor being positioned over the hyperlink within the tooltip and the activation of the switch.
16. The data processing system of claim 9, wherein the tooltip includes a hyperlink displayed within the tooltip, further comprising means for displaying on the display screen linked data in response to the cursor being positioned over the hyperlink within the tooltip and the activation of the switch.

APPENDIX OF EVIDENCE

This is an evidence appendix in accordance with 37 CFR § 41.37(c)(1)(ix).

There is in this case no evidence submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132, nor is there in this case any other evidence entered by the examiner and relied upon by the appellants.

RELATED PROCEEDINGS APPENDIX

This is a related proceedings appendix in accordance with 37 CFR § 41.37(c)(1)(x).

There are no decisions rendered by a court or the Board in any proceeding identified pursuant to 37 CFR § 41.37(c)(1)(ii).